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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,384	11/08/2001	Gregory Wright	215760US28	5139

22850	7590	01/29/2008
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EXAMINER	
BRINICH, STEPHEN M	

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
01/29/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.		Applicant(s)	
	09/986,384		WRIGHT, GREGORY	
	Examiner		Art Unit	
	Stephen M. Brinich		2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitachi Koki Imaging Solutions, Inc. "The Internet Document Controller" (October 2000) in view of Jenkins et al (US 5365310).

Re claims 1, 7, & 13, The Internet Document Controller discloses (pages 3-4, "*i-manage: Remote Device Management*" and "*i-service: More Machine Uptime*") a method and apparatus for monitoring a remote image forming device in which a "remote device management" facility receives information representing an image forming device condition ("*i-service: More Machine Uptime*", page 4 - the described "remote device management" inherently require the transmission of device condition information from the device to the site where the remote diagnosis described under "*i-service: More Machine Uptime*" occurs). This device condition information includes (page 4, middle right figure indicating the display at the remote location) a first parameter indicating a number of pages which, when exceeded, will trigger a display of a "maintenance warning"

message. In order for this first parameter to serve the indicated function (of triggering a "maintenance warning" upon that number of pages being exceeded), a related second parameter indicating the number of pages that have been printed by the device must inherently be received and compared with the first parameter (which comparison inherently requires that the two parameters are stored for at least long enough to carry out this comparison).

Re claims 1, 3, 6-7, 9, 13, & 15, The Internet Document Controller mentions ("i-service: More Machine Uptime", page 4) the running of a "diagnostic" (i.e. test) procedure is run on the remote image forming device. As noted above, The Internet Document Controller describes a "remote diagnostics" operation (i.e. the test is conducted at a location remote from the image forming apparatus). The above described operation of comparing a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message and the number of pages printed by the device subsequent to such a diagnostic procedure would thus read on the claim requirement that the recited parameter is obtained after the remote image forming device is operated to execute a test operation.

The Internet Document Controller does not specify the location (at the image forming apparatus or at the remote device management site) at which the comparison is performed.

Jenkins et al discloses (column 7, lines 45-55) a remote device management facility in which a comparison of parameter information is performed at the remote site (i.e. remote from the image forming device).

Jenkins et al and The Internet Document Controller are combinable because they are from the field of remote management of image forming devices.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to perform the comparison of the number of pages currently printed and the threshold number of pages that triggers a warning at the remote site (which would inherently require the transmission of this device condition information from the device to the site where the remote diagnosis occurs).

The suggestion/motivation for doing so would have been to provide a cost-effective monitoring arrangement (an advantage described by Jenkins et al at column 8, lines 36-41) by allowing a single remote device management site to perform the check for

a plurality of image forming devices (as described by Jenkins et al at column 2, lines 12-16).

Therefore, it would have been obvious to combine The Internet Document Controller with Jenkins et al to obtain the invention as specified in claims 1, 3, 6-7, 9, 13, & 15.

Re claims 2, 8, & 14, The Internet Document Controller further discloses (page 4, middle right figure) a value (corresponding to the recited "tolerance") indicating a number of pages which, when exceeded, will trigger a display of a "maintenance needed" message (as distinguished from the previously described "maintenance warning" message). The described "maintenance needed" message (to be triggered when the number of pages exceeds the indicated quantity) inherently requires that the second parameter (number of pages printed) and the tolerance value (number of pages that will trigger the "maintenance needed" message) are compared and stored for at least long enough to carry out this comparison.

The Internet Document Controller does not describe a highlighted display of the "maintenance needed" message.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to highlight the "maintenance needed" message.

The suggestion/motivation for doing so would have been to distinguish this message from the (less immediately in need of attention) "maintenance warning" message.

Therefore, it would have been obvious to combine a standard message highlighted display with The Internet Document Controller in view of Jenkins et al as applied to claims 1, 3, 6-7, 9, 13, & 15 to obtain the invention as specified in claims 2, 8, & 14.

Re claims 4-5, 10-11, & 16-17, The Internet Document Controller discloses ("i-service: More Machine Uptime", page 4) the use of e-mail to communicate between the remote image forming device and the remote location that receives information representing an image forming device condition.

Re claims 6, 12, & 18, The Internet Document Controller discloses ("i-service: More Machine Uptime", page 4) the performance of adjustments at the remote location to be transmitted to the remote image forming device resulting in a modification to the condition of the remote image forming device.

3. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Internet Document Controller in view of

Jenkins et al as applied to claims 1, 7, & 13 above, and further in view of Morrell (US 4742483).

The Internet Document Controller in view of Jenkins et al does not specify the use of tests determined upon image forming system initialization or tests specifically directed to temperature or voltage.

Morrell discloses (column 4, lines 48-57) a copier diagnostic arrangement including copier warmup (i.e. initialization) testing and heater element (i.e. temperature) testing.

The Internet Document Controller in view of Jenkins et al and Morrell are combinable because they are from the field of copier testing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include warmup testing and temperature testing in the test protocols of The Internet Document Controller.

The suggestion/motivation for doing so would have been to enable the detection of warmup errors and temperature errors which produce printing failures and poor quality conditions.

Therefore, it would have been obvious to combine The Internet Document Controller in view of Jenkins et al with Morrell to obtain the invention as specified in claims 19-24.

Response to Arguments

4. Applicant's arguments (11/13/07 Remarks: page 11, line 6 - page 15, line 24) have been fully considered but they are not persuasive.

Applicant argues (11/13/07 Remarks: page 11, line 10 - page 15, line 3, particularly page 13, line 13 - page 15, line 3) that Hitachi specifies that the comparison corresponding to the recited comparison of the present invention is performed within the image forming device, and that this teaches away from the invention as claimed (which recites that the comparison is performed remotely). Applicant cites as examples cases where the i-service module receives "Toner low" or "Stapler empty" condition alerts from the image forming device.

However, Hitachi does not specify that the comparison which triggers a "maintenance warning" or "maintenance needed" alert is performed within the image forming device.

Applicant argues (11/13/07 Remarks: page 15, lines 4-19) that Examiner has relied upon hindsight reasoning in concluding

that the remote comparison diagnostic of Jenkins may be combined with the maintenance alert system of Hitachi.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the present case, Examiner has cited a specific teaching of Jenkins which provides a rationale for performing this comparison remotely rather than within the image forming device. As noted by Jenkins (column 8, lines 36-41), performing this comparison within the image forming device rather than within the remote diagnostic system "is not the most cost effective or preferred method". Thus, Jenkins provides a rational underpinning (cost effectiveness) for performing this comparison remotely rather than within the image forming device.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of

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a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300.

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Stephen M Brinich
Examiner
Technology Division 2625

smb *smb*
January 16, 2008



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